

REMARKS

- Claims **1-50** are pending in the present application.
- Of the pending claims, only claims **1, 14, 27 and 39** are independent.
- All of the pending claims stand rejected under 35 U.S.C. §103(a). No claims have been amended herein, for the reasons set forth below.
- The specification has been amended herein to remove embedded hyperlinks, in response to Examiner's objection in ¶ 4, pg. 2 of paper no. 11. No new matter has been added.

I. RCE

Since the last Office Action had been a Final Office Action rejecting all pending claims, a Request for Continued Examination, pursuant to 37 C.F.R. §114, is being timely filed herewith. A Notice of Appeal had been filed for the present application on September 04, 2002. Pursuant to 37 C.F.R. §114(d), the filing of this R.C.E. is a request to withdraw the Appeal and to re-open prosecution of the present application.

II. TELEPHONE INTERVIEW

Applicants thank Examiner for extending the courtesy of a telephone interview on August 14, 2002. Discussed during the interview was U.S. Patent No. 6,167,435 to Druckenmiller et al. (hereinafter Druckenmiller) as it applied to the pending claims. Applicants gratefully acknowledge Examiner's agreement during the interview that the present invention is patentably distinguishable from the system disclosed in Druckenmiller. During the interview, Examiner indicated that the pending claims should be amended in order to distinguish over Druckenmiller. Examiner suggested amending claim 1, for example, such that the step of "selecting" recites in more detail why the e-mail messages are being targeted. However, as Applicants argued during the interview and as is explained in detail below, Applicants respectfully submit that the claims in their present form are already patentably distinguishable from Druckenmiller. Accordingly,

Applicants have not amended any claims herein but present arguments as to why Druckenmiller, alone or in combination with any other prior art of record, fails to teach or suggest each limitation of the pending claims, and why the §103(a) rejection should be withdrawn.

III. SECTION 103(a) REJECTIONS

1. Summary of rejection for claims 1, 5 – 12, 14, 18 – 25, 27, 31 – 39, and 43 – 50.

Claims 1, 5 – 12, 14, 18 – 25, 27, 31 – 39, and 43 - 50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,167,435 to Druckenmiller et al. (hereinafter Druckenmiller). Applicants respectfully traverse the Examiner's §103(a) rejection.

As best as Applicants can understand it, Examiner's reasoning for this rejection is as follows:

- (a) Selecting an e-mail mailing list from a plurality of e-mail mailing lists is known;*
- (b) It is known to select an e-mail mailing list that has a higher response rate than an e-mail mailing list with a lower response rate;*
- (c) Druckenmiller discloses sending an e-mail message to a member of an e-mail mailing list and receiving a response; and
- (e) although Druckenmiller does not disclose a postal mailing address or postal mailing lists, Druckenmiller does disclose demographic information being associated with members of an e-mail mailing list. Since geographic data such as a postal mailing address may be the type of demographic information that may be associated with e-mail mailing list members in Druckenmiller, it would have been obvious to one of ordinary skill in the art to use postal mailing addresses associated with members of an e-mail mailing list to select a group of the members of the e-mail mailing list as recipients for an e-mail.

**Examiner made general assertions about "mailing lists", without specifying whether e-mail mailing lists or postal mailing lists were being referred to. Since the prior art Examiner cited on the record is limited to e-mail mailing lists, Applicants have made the*

assumption that these are the types of mailing lists Examiner was referring to in the remainder of his comments.

If Applicants are mistaken in their understanding of Examiner's reasoning, Examiner is kindly invited to correct Applicants understanding in the next Office Action.

2. Applicants traversal of §103(a) rejection

Examiner has not established a prima facie case of obviousness for the rejected claims because Examiner has not addressed certain limitations of the pending claims. In particular, Examiner has not addressed the following limitations, which are each present in each of the pending claims:

(i) *sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members"* (emphasis added)

AND

(ii) *"selecting for use, based on the responses received in [the previous step], one of the plurality of postal mailing lists",* (emphasis added)

where the "responses received in the previous step" are responses to the e-mail message sent in (i), each response corresponding to a list member from one of the subsets of list members.

Further, the above limitations are not taught or suggested by the prior art of record, alone or in combination.

2(a). Examiner has not addressed limitation (i), above, in presenting the §103(a) rejection.

Regarding limitation (i), none of the prior art of record teaches or suggests sending an e-mail message to a subset of list members of a postal mailing list. Examiner has not even *asserted* that such a feature is taught or suggested by the prior art or that it would have been

obvious to one of ordinary skill in the art at the time of Applicants invention to modify the prior art such that it would include such a feature, much less pointed to particular evidence in the record supporting such an assertion (*e.g.*, by pointing to a suggestion in the prior art or within the general knowledge of one of ordinary skill in the art). This feature of Applicants' claimed invention allows a business to realize the benefits of using a postal mailing list (*e.g.*, higher responsiveness to certain types of direct mail if it is delivered through postal mail rather than e-mail) and to maximize those benefits by pre-testing a plurality of postal mailing lists before selecting one for use, without incurring any substantial costs. A business utilizing Applicants invention can pre-test the expected responsiveness of members of a postal mailing list by using the inexpensive method of sending e-mail messages to the members.

Examiner has asserted that Druckenmiller teaches sending an e-mail message to members of an e-mail mailing list (summarized by Applicants as part (c) of Examiner's reasoning, above). Applicants agree with this assertion. However, Applicants note that Druckenmiller does not discuss postal mailing lists, much less sending an e-mail message to members of a postal mailing list. Examiner has not even *asserted* that it would be obvious to combine the teachings of Druckenmiller with postal mailing lists in order to send an e-mail message to a subset of members of a postal mailing list (which is what is claimed herein), much less provided evidence of why such a modification to Druckenmiller would have been obvious to one of ordinary skill in the art (*e.g.*, by pointing to a particular suggestion in the prior art or to particular knowledge of one of ordinary skill in the art).

The closest reference by Examiner to a postal mailing list as related to Druckenmiller is Examiner's acknowledgment that Druckenmiller does not disclose a postal mailing address for members of the e-mail mailing list (pg. 3 of paper no. 11). Examiner asserts, however, that since Druckenmiller discloses that demographic information may be stored in association with the subscribers of an e-mail mailing list, "it would have been obvious to one of ordinary skill in the art...to use the demographic of a postal mailing address as a selection device for identifying possible mail recipients." As best as Applicants can understand this statement, Examiner appears to be taking the position that since postal addresses may be considered a type of demographic information, and since demographic information may be stored in association with members of an e-mail mailing list in Druckenmiller, it would have been obvious to use the

demographic information of a postal mailing address to select which member of an e-mail mailing list in Druckenmiller to send an e-mail message to.

Applicants are claiming a method for selecting for use one postal mailing list of a plurality of postal mailing lists based on responses to an e-mail message that had been sent to a subset of members of each such postal mailing list. Examiner's statement does not address the actual claim limitation of sending, for each of a plurality of postal mailing lists, an e-mail message to each of a subset of list members. The record does not provide any evidence of why one of ordinary skill in the art would have found it obvious to apply the Druckenmiller system to send e-mail messages to members of a postal mailing list. Examiner merely offers the conclusory assertion that a postal address may be used to select which members of an e-mail mailing list to send an e-mail message to.

In summary, regarding limitation (i), Examiner has not provided any evidence that it is known, or would have been obvious, to send an e-mail message to a subset of members of a postal mailing list. Accordingly, Applicants respectfully submit that Examiner has not addressed limitation (i), which is included in each of the pending claims.

2(b). Examiner has not addressed limitation (ii), above, in the §103(a) rejection.

Regarding limitation (ii), the prior art does not teach selecting a postal mailing list from a plurality of postal mailing list based on responses to an e-mail message sent to a subset of members of each of the postal mailing lists. The Examiner has not even *asserted* that the prior art teaches such a feature or that it would be obvious to modify the prior art to include such a feature, much less provided any evidence for such an assertion.

Examiner has asserted that selecting an e-mail mailing list from a plurality of e-mail mailing lists is known (summarized by Applicants as part (a) of Examiner's reasoning, above). Applicants agree with this assertion. Applicants also submit that selecting a postal mailing list from a plurality of postal mailing lists is known. However, the record lacks any evidence that it would be obvious to select a postal mailing list from a plurality of postal mailing lists based on responses to an e-mail message that had been sent, for each of a plurality of postal mailing lists, to each of a subset of list members. Moreover, as discussed above, sending an e-mail message to each of a subset of postal mailing list members, each subset corresponding to a postal mailing

list, is not taught or suggested by the prior art. Examiner has not asserted, much less provided any evidence, that such a feature is taught or suggested by the prior art. Further, Examiner has not asserted that selecting a postal mailing list for use based on such a factor is known in the prior art, much less provided evidence for such an assertion.

Selecting a postal mailing list based on such a factor, in accordance with Applicants' claimed invention, injects a substantial amount of confidence into a business's selection of a postal mailing list for use. In the prior art, a business that is attempting to select a postal mailing list has had limited and stale information on which to base such a selection. Typically, the business must select a postal mailing list based on a response rate of the postal mailing list to one or more prior postal mailings, which may or may not be relevant to what the subject business is planning on mailing. Applicants' claimed invention allows a business to make a selection of a postal mailing list, not an inexpensive proposition, based on fresh data that was not available to a business making such a selection prior to Applicants' invention. Applicants' claimed invention provides the business with data on how subsets of members from a plurality of available postal mailing lists responded to a test e-mail message (*e.g.*, that contained information similar to that in the planned postal mailing for which the postal mailing list is being selected).

Examiner has also asserted that it is known to select an e-mail mailing list with a higher response rate rather than an e-mail mailing list with a lower response rate (summarized by Applicants as part (b) of Examiner's reasoning, above). Examiner has not provided any evidence for such an assertion and Applicants request herein that Examiner do so if Examiner continues to rely on this assertion. As discussed in the Background section of the specification, a response rate for a postal mailing list, prior to Applicants' invention, was determined based on responses to previous postal mailings by the members of a postal mailing list. It was not known or suggested to determine a response rate for a postal mailing list by sending an e-mail message to each of a subset of list members.

Applicants note that Druckenmiller is concerned with creating an e-mail mailing list that is likely to have a relatively high response rate because the members of the list have twice indicated that they wish to be on the list. Accordingly, Druckenmiller is not concerned with how to select an e-mail mailing list that has a higher response rate than another e-mail mailing list because Druckenmiller is concerned with a different problem: creating an e-mail mailing list

rather than selecting amongst available e-mail mailing lists. There is no suggestion to modify Druckenmiller with a feature of testing which of a plurality of e-mail mailing lists has a higher response rate. On the contrary, Druckenmiller presupposes that any e-mail mailing list that is created using the Druckenmiller system will have a very high response rate (since the members have twice affirmatively indicated a desire to be on the mailing list).

In any event, Applicants claim selecting a postal mailing list based on responses to an e-mail message that was sent, for each of a plurality of postal mailing lists, to each of a subset of list members. Further, Applicants note that the claim language is not limited to selecting a postal mailing list based on a *response rate* that is determined based on responses to the e-mail message. For example, also encompassed by the claim language are embodiments described in the specification wherein a postal mailing list is selected based on how relatively favorable the responses to the e-mail message are.

In summary, Examiner has failed to address limitation (ii), above, which is present in each of the pending claims and thus has not presented a proper prima facie case of obviousness for the pending claims.

2(c). Applicants claimed invention as a whole is not obvious over the prior art of record, alone or in combination.

Businesses spend substantial amounts of money on buying or renting a postal mailing list and then on actually producing and mailing out the direct mailing materials. Since sending out direct mail via a postal mailing is not an inexpensive proposition, business are very concerned with selecting the most effective postal mailing list for their planned direct mail materials. However, prior to Applicants' claimed invention, businesses have not been able to pre-test the effectiveness of a plurality of available postal mailing lists. Applicants claimed invention allows a business to determine the expected effectiveness of a plurality of available postal mailing lists before selecting one for use. Applicants claimed invention provides a business that is selecting a postal mailing list with additional data on which to base the selection, data that was previously unavailable to such a business. Applicants' recognized that using e-mail messages to test the expected responsiveness of members of a plurality of postal mailing lists is an inexpensive,

quick, and efficient method of improving the process for selecting a postal mailing list. The fact that businesses have been motivated for many years to improve this process, due to the costs of sending out a postal direct mailing, and have not recognized Applicants' solution, is evidence of the non-obviousness of Applicants' solution.

2(d) 103(a) Rejections of claims 6, 13, 15 – 17, 26, 28 – 30, and 40 – 42

Claims 6, 13, 15 – 17, 26, 28 – 30, and 40 – 42 have each been rejected under 35 U.S.C. §103(a) over Druckenmiller in light of miscellaneous other art. Claims 6, 13, 15 – 17, 26, 28 – 30, and 40 – 42 are each dependent on an independent claim that recites both of the limitations discussed above, and thus each also include the limitations. Accordingly, Applicants respectfully submit that each of these claims is patentable at least for the reasons set forth above.

3. Request for Documentation in Support of Official Notice under MPEP 2144.03

Applicants note that Examiner, in his assertion that e-mail mailing lists that have a higher response rate are more valuable than e-mail mailing lists with a lower response rate, stated that “inherently, selection of mailing lists that provide positive proof of increased and voluntary participation are more valuable than lists which have old, untested, or unresponsive members.” (emphasis added). Applicants assume that this statement is the taking of Official Notice by the Examiner. Applicants note that Examiner has not provided any evidence on the record to support the above statement and herein request that Examiner do so in a future Office Action if Examiner continues to rely on such a statement. Applicants cannot respond to Examiner's assertions of how e-mail mailing lists are selected in the prior art without being provided with documentation that sets out the meets and bounds of the prior art practices.

Further, Applicants are unsure what Examiner means by the term “untested”. If Examiner is implying that the response rate of e-mail mailing lists is in any way tested before the e-mail mailing list is selected for use, Applicants dispute that such a feature exists in the prior art

and request that Examiner provide support for such an assertion via a document that describes such a feature.

Applicants also note that examiner has stated that “it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response.” Further, Applicants assume that this statement is a taking of Official Notice by Examiner. Examiner has not provided any evidence in the record to support the statement and Applicants request that the Examiner do so in a future Office Action if the statement is continued to be relied upon, so that Applicants can adequately understand and respond to the teachings of the prior art.

If Examiner is aware of particular methods of determining or calculating a response rate for an e-mail mailing list or postal mailing list that Examiner is relying upon in his §103(a) rejection, Applicants respectfully request that Examiner provide documentation of such methods so that Applicants may adequately understand and respond to the prior art.

4. Examiner’s characterizations of claimed invention.

Applicants respectfully submit that Examiner may be misconstruing Applicants’ claimed invention. Examiner repeatedly refers to Applicants’ claimed invention as “the subscription verification method as disclosed in the rejected claims 1, 14, 27, and 39.” Applicants object to this characterization of the claimed invention since no subscription or verification features are recited in the claims.

Also, Examiner seems not to distinguish between the concept of selecting a mailing list from a plurality of mailing lists (what is claimed in the pending independent claims) and selecting a recipient for inclusion on a mailing list that is being created (what is suggested by the prior art). Applicants respectfully submit that it is incorrect to use the latter as a statement of the claimed limitations, as Examiner has done throughout the Office Action (see, *e.g.*, full paragraph on pg. 10 of paper 8).

IV. OBJECTION TO SPECIFICATION

The specification was objected to, based on MPEP §608.01, as improperly containing an embedded hyperlink and / or other form of browser executable code on page 1. (pg. 2, ¶ 4 of paper no. 11). Applicants have amended the specification herein to overcome this objection and thus request that it be withdrawn.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

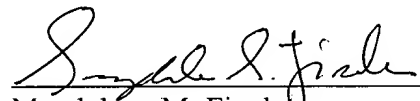
Petition for Extension of Time to Respond

Applicants hereby petition for a two-month extension of time with which to respond to the Office Action. Please charge \$200.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

October 30, 2002
Date


Magdalena M. Fincham
Agent for Applicants
Registration No. 46,085
mfincham@walkerdigital.com
Walker Digital, LLC
203-461-7041 / voice
203-461-7300 / fax

S P E C I F I C A T I O N A M E N D M E N T S
M A R K E D U P F O R M

Please **REPLACE** the paragraph that begins on line 16 of page 1 of the specification and ends on line 26 of page 1 of the specification with the following paragraph:

Many businesses practice direct marketing by utilizing commercially- obtained mailing lists. These lists can be obtained from mailing list brokers such as [Best's Mailing List, Inc. (<http://www.bestmailing.com/>; visited on February 24, 1999)] BEST'S MAILING LIST, INC. or [Nationwide Data Services (<http://www.nationwidedata.com/> ; visited on February 14, 1999)] NATIONWIDE DATA SERVICES. Such mailing lists are typically compiled from various sources such as public real-estate documents, census bureaus, financial publications, and direct mail respondents. Members of the list, that is, people whose information is used to compile the list, typically consist of individuals who have provided information about their lifestyles and product usage through detailed surveys. For example, computer hardware or software purchasers that send in software and hardware vendor registration cards and surveys are typically placed on a mailing list geared towards the PC and technology industry.

: